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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,784	10/20/2000	Arturo A. Rodriguez	A-6690	8546

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	5

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/693,784	RODRIGUEZ ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 October 2000* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective because it was not executed in accordance with either 37 CFR 1.66 or 1.68. In particular, the oath is missing the signature of Arturo A. Rodriguez. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,978) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 6-8, 11-82 of this application. With respect to claims 6-8, 16-18, 26-28, and 36-38, the examiner is unclear as to where support is found pertaining to usage of the remote controller. In consideration of claims 11, 21, 31, and 41, the examiner is unclear as to where support is found for the claimed particulars such that the "client" or "server" comprise the "means" or a "processor" and "memory" that "store" the "media title list". Finally, with respect to claims 48 and 65, while the provisional application makes reference to the establishment of "reminders", the provisional application provides no specific details as to how this might be performed in the manner that is claimed.

3. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,488, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-3) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application pertaining to the adding of a selected media title to either a "shopping" or a "reminder" list.

As the examiner is unclear as to where the claimed subject matter may be supported in the parent application, the claims of the instant application shall be examined in view of the filing date of the instant application (19 October 2000).

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 90 (Figure 4) 113 (Figure 6); 181, 182 (Figures 13-15, 18); 254 (Figure 20). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Double Patenting

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Applicant is advised that should claims 7, 17, 27, and 37 be found allowable, claims 6, 16, 26, and 36 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5-13, 15-23, 25-33, 35-43, 45-57, 59, 61-62, 64-75, 77, 79-80, and 82 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn et al. (US Pat No. 5,861,906).

In consideration of claim 1, Figure 1 of the Dunn et al. reference illustrates a method for providing "media information" to a user through an "interactive media services client device" [26] that is "coupled" [36] to a "programmable media services server device" [22] (Col 4, Lines 6-41). The method comprises "receiving user input" via a remote controller (not shown) such that the user may "request that said media title be added to a media title list"

[80] (Col 6, Line 64 – Col 7, Line 4). This request is subsequently "added" to the "media title list" as illustrated in Figure 5 (Col 7, Line 56 – Col 8, Line 22).

Claims 11 and 31 are rejected in view of claim 1. The "client device" [26/50] of claim 1, as illustrated in Figure 2 comprises a "memory for storing data" [56] including a "media list" and a "processor" [52] that is "configured to cause a media title identified by user input to be added to said media title list" (Col 6, Lines 6-26).

Claims 21 and 41 are rejected in view of claim 1. The "server device" [22] comprises "memory" [42/46] for storing a "media list" [110] and an inherent "processor" configured to "cause a media title identified by user input to be added to said media title list" [114] (Figure 6).

Claims 2, 12, 22, 32, and 42 are rejected wherein the embodiment may "receive user input requesting said media title list" [98] and subsequently "proved the viewer with said media list" [102].

Claims 3, 13, 2, 33, and 43 are rejected wherein the "media title list" is operable to "remind" the user as to the "availability" of previously selected programs such that the listed programs of interest are "available" or present for ordering (Col 2, Lines 32-39).

Claims 5, 15, 25, 35, and 45 are rejected wherein the "media title list" is represented by an "icon" [98] (Figure 4) displayed on a "display device" [28].

Claims 6, 16, 26, and 36 are rejected wherein the "media title" may be "identified" via "activation of a button on a remote control device" (Col 7, Lines 15-26).

Claims 7, 17, 27, and 37 are rejected wherein the "media title" may be "identified" via "activation of one or more buttons on a remote control device" (Col 7, Lines 15-26).

Claims 8, 18, 28, 38, and 46 are rejected wherein the wherein the "media title list" is selected from a group consisting of a "reminder list" [98] (Figure 5) and a "shopping list" [76] (Figure 9).

Claims 9, 19, 29, 39, and 47 are rejected wherein the "media title" is a "video-on-demand media title" that is displayed on a "television screen" (Col 4, Lines 18-21, 42-49).

Claims 10, 20, 30, and 40 are rejected wherein "information supplied by the user" or viewer ID is associated with "said media title" such that it may be later retrieved (Col 7, Lines 61-66; Col 9, Lines 40-51).

In consideration of claims 48 and 65, Figure 1 of the Dunn et al. reference illustrates a method for providing "media information" to a user through a "interactive media services client device" [26] that is "coupled" [36] to a "programmable media services server device" [22] (Col 4, Lines 6-41). The method comprises "selection logic" for "receiving user input" via a remote controller (not shown) that enables the user to "associate said with media title with a media title list" [80] (Col 6, Line 64 – Col 7, Line 4). The user may subsequently be "provided" via "reminder logic" a "reminder in connection with said media title" [98] such that the viewer is "reminded" as to previously designated programs of interest that were added to the media list [102] of Figure 5 (Col 2, Lines 33-39; Col 7, Line 56 – Col 8, Line 22).

Claims 49 and 66-67 are rejected wherein the client device is a "television set-top box" that performs the "reminder logic" and "association logic" under the direction of a "processor" [52] (Col 5, Line 59 – Col 6, Line 10).

Claim 50 is rejected wherein the "reminder" is provided via a "television" [28].

Claims 51 and 69 are rejected wherein the embodiment is operable to "receive user input requesting a video presentation identified by said media title" [142] (Col 10, Lines 54-58) and to "prompt said user to provide input whether said media title should be deleted from said media list" [122] (Col 9, Lines 33-50).

Claims 52 and 70 are rejected wherein the user "identifies a name" of a star of interest and may subsequently "associate said name with said media title list" in order to create a filtered list of programs of interest (Col 9, Line 52 – Col 10, Line 17).

Claims 53 and 71 are rejected wherein the embodiment is operable to "receive user input identifying a second media title" [80] (Figure 6) and to subsequently "associate said second media title with a second media title list" as aforementioned. The "first media list" would be construed as the user "list" comprising those titles prior to the association of the new "media title".

Claims 54 and 72 are rejected wherein the embodiment is operable to "receive user input from a second user identifying a second media title" [80] and to subsequently "associate said second media title with a second media title list". The reference discloses that the embodiment is operable to store customized media lists comprising multiple for multiple users (Col 5, Lines 51-58).

Claims 55 and 73 is rejected wherein the "media title list" may be a "pre-defined media title list" organized by star name, category type, or kind (Col 6, Lines 54-63; Col 9, Line 51 – Col 10, Line 13).

Claims 56 and 74 is rejected wherein a "category for said media title list" is from a group consisting of "foreign" (Col 6, Lines 60-63).

Claims 57 and 75 is rejected wherein the "media title list" may be identified by a "date" as is the case of media designated as "oldies" (Col 6, Lines 60-63).

Claims 59 and 77 are rejected wherein "data identifying said media title" may be stored in a "database" [46].

Claims 61 and 79 are rejected wherein the embodiment is operable to "provide said user with a video presentation corresponding to said media title" [142] (Col 10, Lines 54-58) and to "prompt said user to provide input whether said media title should be deleted from said media list" [122] (Col 9, Lines 33-50). The prompt is displayed before, during and "after" the presentation.

Claims 62 and 80 are rejected wherein the "user input is provided via a remote control device" (Col 7, Lines 15-26).

Claims 64 and 82 are rejected wherein "visual feedback" is provided to the user so as to "confirm that said media title has been associated with said media list" as illustrated in Figure 5.

Claim 68 is rejected wherein the embodiment comprises "logic" such that the "media title list" may be associated with a "text string identified via user input" such as a "text string" representing the name of a star of interest. This "text string" may subsequently be utilized to "cause said media title list to be associated "such that a filtered list of programs of interest is displayed (Figure 9; Col 9, Line 52 – Col 10, Line 17).

9. Claims 48 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawler et al. (US Pat No. 5,699,107).

In consideration of claims 48 and 65, Figure 1 of the Lawler et al. reference illustrates a method for providing "media information" to a user through a "interactive media services client device" [18] that is "coupled" [14] to a "programmable media services server device" [26]. The method comprises "selection logic" [58] for "receiving user input" via a remote controller [22] that enables the user to "associate said with media title with a media title list" or list of programs for which reminders are to be provided which resides at the headend [12] (Col 12, Lines 16-34). The user may subsequently be "provided" via "reminder logic" a "reminder in connection with said media title" (Figure 9) at the appropriate time.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 4, 14, 24, 34, 44, 58, 60, 63, 76, 78, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (US Pat No. 5,861,906).

In consideration of claims 4, 14, 24, 34, and 44, the Dunn et al. reference discloses that items added to the media list may be automatically removed if not rented within a certain period of time (Col 8, 46-55). The reference, however, does not explicitly disclose nor preclude that the user may be "reminded" that this program may be "no longer be available" from the user-selected list. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Dunn et al. embodiment, if necessary, to provide the user with a "reminder" that the "media title" will "no longer be available" from the custom list for the purpose of providing the user with a friendly notification that the deletion is about to occur such that a user is not confused/frustrated when a previously selected item of interest mysteriously disappears from a custom developed media list.

In consideration of claims 58 and 76, the Dunn et al. reference, as aforementioned, discloses a method wherein a "video presentation identified by said media title" may be associated with a particular "list" of programming based on it's particular category. For example, new programs [92] or those "currently available" to rent may be associated with a "first list" (Col 6, Lines 25-36). The reference, however, does not explicitly disclose nor preclude the addition of additional categories including those recognizable in the art as "coming soon" or "coming attractions". The reference suggests that the embodiment is analogous to shopping at a video store and as is well known to those of ordinary skill in the art video stores often advertise movies that are currently "not available" (Col 1, Line 56 –

Col 2, Line 2). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Dunn et al. reference, if necessary, to further to "associate" a "video presentation identified by said media title" that is "not currently available" with a list or category such as "coming soon" or "coming attractions" for the purpose of facilitating the creation of a customized list of personal favorites that he/she might wish to watch some day based on watching of upcoming movie trailers (Col 6, Line 64 – Col 7, Line 4) in a manner that does not require for a user to remember how to intelligently traverse through various screen menus to find these movies of interest once they become available for rental (Col 2, Lines 12-17).

In consideration of claims 60 and 78, the reference discloses that the "data identifying said media title" may be stored in an SQL database [46], however it does not explicitly classify that database as comprising "non-volatile memory". The usage of "non-volatile memory" [46] in conjunction with disk subsystems is well established in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize "non-volatile memory" since it was known in the art that SQL databases [46] / servers utilize disk subsystems.

In consideration of claims 63 and 81, the Dunn et al. reference while "providing visual feedback to said user" does not disclose or preclude a selection technique whereby the "said media title moves toward an icon". The use of drag-and-drop operations is well known in the art. It would have been an obvious matter of design choice to facilitate media object selection in a manner that "provides visual feedback to said user showing said media title moving toward an icon", since applicant has not disclosed that that particular visual

representation solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with other media object selection techniques. Alternatively, the use of a drag-and-drop operation and associated visuals would have been obvious to one of ordinary skill in the art to implement in conjunction with the Dunn et al. embodiment for the purpose of utilizing a familiar GUI operational method that would further providing the user a sense of control and familiarization (Col 9, Lines 46-50). It is feasible that such a method could supplement the means for selecting an object whereby a user may either click on the "add to list" button or drag a selected media title onto it.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Chapuis et al. (US Pat No. 6,023,267) reference discloses a process for storing and selecting lists of television programming events.
- The Ishizaki et al. (US Pat No. 6,243,142) reference discloses a method for placing reservations for video-on-demand programs.
- The Saib et al. (US Pat No. 6,292,624) reference discloses a method for selection/deselection of timer recording.

- The Proehl et al. (US Pat No. 6,532,589) reference discloses a method and apparatus for providing a calendar-based-on-screen planner that may be used for creating and establishing reminders.
- The LaJoie et al. (US Pat No. 5,850,218) reference discloses a system and method for providing a full service cable television system that facilitates the ordering and establishing of reminders for selected programs.
- The Schein et al. (US Pat No. 6,323,911) reference discloses a television schedule system that facilitates the customization of the schedule guide to include the addition of programs to a list of reminder timers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB
September 16, 2003

JOHN MILLER
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